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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,039	01/06/2006	Rene Geiger	62448A	1490
109 7590 04/01/2009 The Dow Chemical Company Intellectual Property Section P.O. Box 1967 Midland, MI 48641-1967				
EXAMINER				
GOLOBOY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
04/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,039

Applicant(s)

GEIGER ET AL.

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2005 and 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8, 10-14, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, 10-14, and 16-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 10, line 18, "Polyglocol A" should be "Polyglycol A". On page 10 line 28, "70 wt 5" should be "70 wt percent".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 and 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8, and its dependent claims, recite a "low viscosity" base stock traction fluid. However, the term "low viscosity" is not defined in the application, and the claim is indefinite as it is not clear what qualifies as a "low viscosity" base oil.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6, 8, 10-14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Walters (U.S. Pat. No. 5,342,531).

In column 1 lines 46-59, Walters discloses lubricating compositions comprising a major proportion of polyalkylene glycol (polyglycol). From column 5 line 11 through column 6 line 30 Walters discusses the polyglycol. In column 5 lines 19-26 Walters discloses that the polyglycols are formed by the reaction of a 1,2-oxide with an alcohol. In column 5 lines 24-28 Walters teaches that the oxides can be ethylene oxide, propylene oxide, butylene oxide, or cyclohexene oxide, as recited in claims 6 and 14 and also meeting the limitations of claim 13. In column 5 lines 58-65 Walters teaches that the alcohols can be several of those recited in claims 3 and 11, including monoethyleneglycol (ethylene glycol), 2,3-butanediol (2,3-butylene glycol), or trimethylolpropane as also recited in claims 4 and 12. The polyglycols formed as the reaction products of the 1,2-oxides and alcohols or Walters will therefore meet the limitations of the polyglycols of claims 1-4 and 6. In column 6 lines 25-30, Walters discloses that the composition can further contain additional lubricating oils such as mineral oils and polyalphaolefins, which are suitable base stock traction fluids as defined on page 6 lines 1-9 of the specification. Walters therefore also discloses compositions meeting the limitations of claims 8 and 10-14. In column 1 lines 46-59 Walters discloses that the composition further comprises an antiwear or extreme pressure agent, an antioxidant, and a corrosion inhibitor, all as recited in claim 16.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-4, 6, 8, 10-14, and 16-17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walters in view of Toussaint (U.S. Pat. No. 2,293,868)

The discussion of Walters in paragraph 5 above is incorporated here by reference. Walters discloses a process for making the polyglycol of claim 17 by reacting an oxide and an alcohol, but does not disclose doing the reaction in the presence of a catalyst.

In column 1 lines 1-4, Toussaint discloses an improvement in catalytic processes for making reaction products of alkylene oxides with glycol, such as in the reaction of Walters where the alcohol is a glycol. In column 1 lines 33-46, Toussaint teaches that acidic compounds of fluorine, particularly boron trifluoride, are suitable catalysts. The

use of the boron trifluoride catalysts of Toussaint in the reaction of Walters meets the limitations of claim 17, and additionally the use of polyglycols formed by the process meet the limitations of claims 1-4, 6, 8, 10-14, and 16.

It would have been obvious to one of ordinary skill in the art to use the catalyst of Toussaint in making the polyglycols of Walters, as Toussaint teaches in column 2 lines 17-22 that it is effective in even small quantities and forms products low in color.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797